REMARKS

The Office Actions dated December 18, 2002, and July 2, 2003, have been received and carefully considered. Claims 1-8 are pending in the present application.

In this response, claims 9-12 have been added and claims 1, 4, 5, and 8 have been amended. Entry of added claims 9-12 and the amendments to claims 1, 4, 5, and 8 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

Please note that declarations supporting the removal of the Srinivasan reference were previously submitted on April 15, 2003.

I. THE ANTICIPATION REJECTION OF CLAIMS 1, 3-5, 7, AND 8

On page 2 of the Office Action, claims 1, 3-5, 7, and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated by Foster (U.S. Patent No. 6,332,134). This rejection is hereby respectfully traversed with amendment.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose,

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either expressly or under the principles of inherency, each and every element of the claimed invention. Id.. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id..

Regarding claims 1, 3-5, 7, and 8, the Examiner asserts that Foster teaches the present invention as claimed. However, Foster teaches a system wherein a cardholder transmits a request to pay directly to a card company (see column 8, lines 13-18). In contrast, the present application, as amended, claims receiving transaction information from a vendor at a secured network (see claims 1 and 5). Support for this claimed receiving process is found in Figure 1 and page 9, lines 15-16. This claimed receiving process is opposite to the teaching of Foster. Indeed, Foster teaches away from such a receiving process by teaching away from a prior art process whereby a

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merchant directly makes a credit card charge to a card company (see Figure 1 and Background of the Invention section).

Claims 3, 4, 7, and 8 are dependent upon independent claims 1 and 5. Thus, since independent claims 1 and 5 should be allowable as discussed above, claims 3, 4, 7, and 8 should also be allowable at least by virtue of their dependency on independent claims 1 and 5.

In view of the foregoing, it is respectfully submitted that the anticipation rejection of claims 1, 3-5, 7, and 8 is not proper at this time, and the withdrawal of such rejection is respectfully requested.

At this point it should be noted that claims 9-12 have been added to include certain additional subject matter that is not claimed, disclosed, or even suggested by Foster.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 2 AND 6

On pages 2 and 3 of the Office Action, claims 2 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster (U.S. Patent No. 6,332,134) in view of Srinivasan (U.S. Patent Application Publication No. US 2002/0077922). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there

must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both

be found in the prior art, not in applicant's disclosure. *In re*

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as

stated in MPEP § 2143.01, obviousness can only be established by

combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion,

or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill

in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). The mere fact that references can be combined or

modified does not render the resultant combination obvious

unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.

Cir. 1990). Further, as stated in MPEP § 2143.01, to establish

prima facie obviousness of a claimed invention, all the claim

limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner acknowledges that Foster does not disclose the use of a VPN for enabling secured communication of transaction information. However, the Examiner asserts that Srinivasan teaches a method of performing electronic transactions using a VPN such that it would have been obvious to modify Foster in view of Srinivasan so as to arrive at the present invention as claimed.

The Srinivasan reference was filed December 15, 2000, as U.S. Patent Application No. 09/738,531. Thus, the Srinivasan reference has an effective filing date of December 15, 2000.

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Applicants respectfully submit that the invention disclosed and claimed in the present application was conceived prior to December 15, 2000. Applicants also respectfully submit that they were duly diligent in preparing and filing the present application from the date of conception of the invention disclosed and claimed in the present application to the filing date of the present application (i.e., December 28, 2000). Applicants support the above-stated submissions with inventor declarations under 37 C.F.R. § 1.131, which were submitted in Applicants' response filed April 15, 2003, and which contain a showing of facts that clearly establish the above-stated submissions. Accordingly, the Srinivasan reference is not a proper prior art reference for application against the claims of the present application.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claims 2 and 6 is improper, and the withdrawal of such rejection is respectfully requested.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by

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telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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APPENDIX A

1 (currently amended). A method for enabling E-commerce transactions between a vendor and a consumer <u>using a secured network having stored consumer data and approved vendor information</u>, the method comprising the steps of:

[providing a secured network that stores consumer data and approved vendor information;]

receiving transaction information <u>from the vendor</u> at the secured network;

processing the transaction information to determine whether the transaction information conforms with the stored consumer data and approved vendor information; and

delivering the stored consumer data to the vendor if the transaction information is determined to conform with the stored consumer data and approved vendor information.

2 (original). The method of claim 1, wherein the step of providing a secured network further comprises:

providing a virtual private network (VPN) that enables secured communication of the transaction information.

3 (original). The method of claim 1, wherein the step of processing the transaction information to determine whether the

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transaction information conforms with the stored consumer data and approved vendor information further comprises:

determining whether the transaction information contains a consumer identification indicator; and

determining whether the transaction information contains a vendor identification indicator.

4 (currently amended). The method of claim 3, further comprising:

determining whether the consumer identification indicator conforms with the stored consumer data; and

determining whether the vendor identification indicator conforms with the [stored] approved vendor information.

5 (currently amended). An apparatus for enabling E-commerce transactions between a vendor and a consumer <u>using a secured network having stored consumer data and approved vendor information</u>, the apparatus comprising:

[a secured network that stores consumer data and approved vendor information;]

a transaction receiver that receives transaction information <u>from the vendor</u> at the secured network;

a processor that processes the transaction information to

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determine whether the transaction information conforms with the stored consumer data and approved vendor information; and

a delivery module that delivers the stored consumer data to the vendor if the transaction information is determined to conform with the stored consumer data and approved vendor information.

6 (original). The apparatus of claim 5, wherein the secured network further comprises:

a virtual private network (VPN) that enables secured communication of the transaction information.

7 (original). The apparatus of claim 5, wherein the processor further comprises:

a consumer identification module that determines whether the transaction information contains a consumer identification indicator; and

a vendor identification module that determines whether the transaction information contains a vendor identification indicator.

8 (currently amended). The apparatus of claim 7, wherein the consumer identification module further comprises a first

conformity module that determines whether the consumer identification indicator conforms with the stored consumer data[;]_ and wherein the vendor identification module further comprises a second conformity module that determines whether the vendor identification indicator conforms with the [stored] approved vendor information.

9 (currently added). The method of claim 1, wherein the transaction information comprises one or more of consumer information, vendor information, transaction amount, and delivery type.

10 (currently added). The method of claim 1, wherein the stored consumer data comprises one or more of credit card account numbers, bank account numbers, consumer name, consumer address, preferred delivery address, preferred billing address, and preferred delivery type.

11 (currently added). The apparatus of claim 5, wherein the transaction information comprises one or more of consumer information, vendor information, transaction amount, and delivery type.

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12 (currently added). The apparatus of claim 5, wherein the stored consumer data comprises one or more of credit card account numbers, bank account numbers, consumer name, consumer address, preferred delivery address, preferred billing address, and preferred delivery type.